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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,970	01/10/2006	Matthias Hauser	J&J127USPCT	4949
27777 7590 12/16/2008 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				
EXAMINER				
LOVE, TREVOR M				
ART UNIT		PAPER NUMBER		
1611				
MAIL DATE		DELIVERY MODE		
12/16/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/520,970

Applicant(s)

HAUSER ET AL.

Examiner

TREVOR M. LOVE

Art Unit

1611

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/17/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22-24, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22-24, 26-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-850/8)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 05/08/2006, 05/09/2008, 06/18/2008

DETAILED ACTION

Acknowledgement is made to applicant's Information Disclosure Statements filed 05/08/2006, 05/09/2008, and 06/18/2008. Also, applicant's preliminary amendment filed upon initial filing, 01/11/2005, is acknowledged.

Claims 1-20, 22-24, and 26-27 are pending. Claims 21 and 25 are cancelled. Claims 1, 4-9, 12, 15, 18, 22, and 26 are currently amended per the preliminary amendment file 01/11/2005. Claim 27 is new per the preliminary amendment filed 01/11/2005.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20, 22-24, and 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by McAtee et al (U.S. Patent 6,153,208).

Based on the instant claim language, examiner interprets the instant claimed invention is drawn to an applicator that is not a sheet that is porous or a sheet that is absorbent, but can be in the form of a porous or absorbent puff, pad, sponge, cotton ball, swab, brush, glove, mitt or bar.

McAtee discloses a substantially dry, disposable, personal cleansing article useful for both cleansing the skin or hair (see abstract). The same as **instant claim 1**, said cleansing article comprises a substrate, a surfactant phase, and a lipid phase (see examples 1-5). The article is taught as being flat, thick, circle, square, rectangular or oval pads (see column 15, lines 47-60).

The composition further comprising dialkyl ethers, such as petrolatum (see column 25, line 47 through column 26, line 5, particularly lines 58 and 5). Said lipid phase comprises hardening materials. Said hardening materials are have a melting point between 30° and 250° C, and more preferably between about 37° and about 80° C (see column 32, lines 8-12), this anticipates **instant claims 2 and 3**. Said hardening materials are selected from fatty acid esters such as mono-, di-, or triglycerides (see column 32, lines 21 and 49-50), animal based fats and oils and vegetable oils, such as hydrogenated castor oil or hydrogenated rapeseed oil (see column 32, lines 21, 58, and 67, and column 33, lines 3-4), fatty acids having from about 10 to 40 carbon atoms, such as triglycerides or diglycerides (see column 32, lines 22-23 and column 33, lines 47-48), fatty alcohols such as cetyl alcohol and behenyl alcohol (see column 32, lines 20, 34-48, and claim 10), and alpha-hydroxy fatty acids and fatty acids having from about 10 to about 40 carbon atoms, such as behenic, euric, stearic, and lauric acids (see column 32, line 22 and column 33, lines 12-16), these anticipate **instant claims 4, 5, 6, 7, 9-10, 12-13** respectively. The hardening components are taught as being present in the McAtee in a range of about 0.1% to about 99.9%, and more preferably about 2% to about 25% of the conditioning component (see column 32, lines 1-7), this reads on **instant claims 8, 11, 14**. McAtee also teaches that the lipid phase can comprise 10% petrolatum, 5% tribehenin, 2% vitamin E acetate, 3% synthetic beeswax, 9% polyethylene wax, and 0% water, components (a)-(f) respectively (see column 53, lines 33-42). Furthermore, component (a) can alternatively be a C8-C30 dialkyl ether (see column 25, line 47 through column 26, line 5, particularly noting petrolatum in line 58, and di C8-C30 alkyl ether in line 5), furthermore, wax components are taught as being present in the lipid phase in an amount more preferably between 2 and 25%, such as fatty alcohols, fatty acids, and mono-, di-, and

triglycerides (see column 32, lines 3-7, 18-23, and 49-50) this anticipates **instant claims 15, 16**. In one of the preferred embodiments of McAtee, the lipid phase comprises at least two components that could be considered active agents, specifically, vitamin E acetate and tribehenin (see column 53, lines 36-38), this anticipates **instant claim 17**. Furthermore, vitamin E acetate, also known as tocopheryl acetate, is taught as a non-steroidal cosmetic soothing agent which is useful for treating inflammation of the skin (see column 44, lines 7-9 and 65), this anticipates **instant claims 18 and 19**. McAtee also teaches the addition of thickeners (see column 29, lines 44-55), McAtee also discloses that the active can be a sunscreen (see column 47, line 26 through 65), this anticipates **instant claim 20**. McAtee further discloses that the lipid and aqueous phases can be added sequentially in any order (see column 50, lines 22-24), this anticipates **instant claim 23**. The aqueous and lipid phases are taught as being applied by spraying methods (see column 55, lines 24-26), this anticipates **instant claim 24**. McAtee also discloses a method of cleansing and conditioning the skin or hair with the device of McAtee (see column 51, lines 14-17), this anticipates **instant claims 26 and 27**.

With regards to **instant claim 22**, McAtee teaches that the device disclosed can comprise more than two layers (see column 9, lines 26-28). Furthermore, it is well known in the art when marketing a single use hygiene device to package the device.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

Non-Statutory Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20, 22-24, and 26-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8, 10-14, 16-17, 19-20, and 27 of copending Application No. 10/520,952 or alternatively, claims 1-8, 10-14, 16-17, 19-20, and 27 of copending Application No. 10/521,070. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1, 20, and 27 of either copending application number '952 or '070 teach a product comprising an applicator which is selected from a puff, pad, sponge, cotton ball, swab, brush, glove, mitt or bar. Said applicator has a wax phase applied (this reads on **instant claim 1**).

Copending claims 2-8 are identical to **instant claims 2-8**, save for being dependent from independent claims 1, which are obvious over each other. Furthermore, **instant claims 9-14, 16-19, 22-24, and 26** read on copending claims 10-14, 16, 18, 21-23, 28, 29, 31, 35 respectively. Copending claims 17 and 19 render **instant claim 15** obvious. Copending claims 25 and 26

render **instant claims 20** obvious. Copending claims 21 and 35 render **instant claims 27** obvious. Even though the instant claim 1 is more specific than copending claim 1, the limitations are taught in dependent claims 20 and 27.

The instant claims are anticipated by the copending claims of 10/520,952 since both sets of claims require the limitation of excluding a porous or absorbent sheet, and include puffs, pads, sponges, cotton balls, swabs, brushes, mitts, or bars which are made of the same materials.

Copending application 10/521,070 is a genus of the instant claims. The generic claims of copending 10/521,070 are silent with respect to the porosity and absorbency. Copending 10/521,070 does not exclude the claimed species of applicators and therefore encompasses porous, non-porous, absorbent, and non-absorbent applicators. It therefore would have been obvious to the skilled artisan to employ an applicator such as a pad or sheet in any form (namely porous or non-porous, absorbent or non-absorbent). .

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Conclusion

No claims are allowed. All claims are rejected. No claims are objected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TREVOR M. LOVE whose telephone number is (571)270-5259. The examiner can normally be reached on Monday-Thursday 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TL

/Lakshmi S Channavajjala/
Primary Examiner, Art Unit 1611
December 5, 2008